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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,284	07/11/2001	Ellen Barbara	CITI0230	9290

27510 7590 05/07/2002

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EXAMINER

FULTS, RICHARD C

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/903,284

Applicant(s)

BARBARA ET AL.

Examiner

Richard Fults

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4 & 5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 19, 21, and 22** recite the limitation "trust account" as being prior referenced in claims 20 and 18. There is insufficient antecedent basis for this limitation in these claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-66** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schutzer (US 6,292,789 B1) in view of Citibank.com, October 13, 1999, Internet, (hereinafter Citibank), Nelson, Quicken '99 for Windows for Dummies, 1998 (hereinafter Nelson), and Schrader et al (US 5,903,881) (hereinafter Schrader).
3. Applicant has generally claimed an on-line payment system using a combination of accounts and features. **Schutzer** discloses (see at least columns 1-30, but in particular cols 11-13) all of the elements of claims 1-66 regarding on-line bill payments and purchases, international payments, transaction accounts, multiple service levels, off-line payments and purchases, cash withdrawals, credit card account payments, receiving enrollment information and account designation, and maintaining funds in

accounts. Many of the above elements are inherent in the operation of an account that is the source account for his payment service. Schutzer does not disclose the complete details of enrollment and banking.

Citibank discloses (see pages 1-5) all of the elements of claims 1-66 regarding on-line banking, personal banking, several levels of banking service including debit accounts and money market accounts (deposit account), savings accounts (save for later) and checking accounts (transaction accounts and deposit accounts) and account numbers, credit card accounts and credit lines (credit line), access and transaction cards (ATM cards used at an ATM), bill payment services, fund transfers and ABA numbers, international payments, and conducting and viewing banking activities over the internet.

Inherent is all of the above is the fact that checking and saving accounts and credit cards and other bank services, including bill payment services and ATM cards for use in ATMs (access and transaction cards), are aggressively offered by banks and can be selected as desired by the customer and can be used for virtually whatever use and intended payment/deposit the user cares to make, and to whomever they choose, either on-line or off-line, in whatever amount their balance or credit limit will allow, either to pay credit card balances or to use the credit line to make payments or deposits, whether it be in US or foreign currency, and once created there is no prohibition (unless contrary to an express agreement between the bank/service and the customer) against maintaining however much money in their accounts they choose.

It is also inherent in opening an on-line banking account(s), including with an institution that offers bill payment services or any other organization operating a payment service, that all of the "know your customer" rules apply to the information required to open the account and to enroll in the payment service, and that all needed transaction identification usernames and passwords will be agreed to at the time of account opening/payment system enrollment and conveyed to both, such that transaction validation may be accomplished and information regarding dispute resolution is exchanged.

It is also inherent that all payments out of the customer accounts will only be done upon instructions from the customer, that fund transfers will commonly require a back end validation to confirm that the user is the owner of the payment source account, that credit lines such as loans or overdraft features can be arranged upon request to flow into the checking account (transaction account), and that any credit card transactions will commonly involve providing information regarding the card number, the expiration date, some type of identification identifier, and an a payment authorization from the card issuer.

Nelson discloses (see pages 26-27, 96-111, 130-136, and 259) all of the elements of claims 1-66 regarding on-line bill payments, separate accounting for cleared and uncleared checks (held money features), additional accounts including petty cash, savings, and liability (save for later feature), the inherency of fund transfers including ABA numbers, account numbers, and a person to person payment service (user sending and receiving funds out and into their transaction account).

Schrader discloses (see at least cols 1-22, but in particular cols 1-7) claims 14, 23-24, 32, 46-47, 56-57, and 66 regarding save for later and held money portions of the transaction account, as it is inherent in his uncleared checking account balance for it to become not only the held money portion of the transaction account but also the save for later portion, by writing a check not intended to be cashed (for the purpose of savings), all within the checking (transaction) account.

It would have been obvious to one skilled in the art at the time of the invention to have used an on-line banking checking account as the transaction and hub account for an on-line payment service, and to have used any one of the following as a save for later feature: 1) a savings account, 2) a check to cash recorded in the petty cash account, or 3) an unissued check notation in the transaction checkbook regarding a set-aside for a save for later amount that would not be cashed but would become a held money amount. It would have been equally obvious to use a checking account number as a method of making payment for a purchase, to use a debit card to make charges to a checking (transaction) account for purchases, payments, and fund transfers, for the user to provide instructions to the financial institution regarding any fund transfers

involving either the transaction account or the credit line, and for there to be an identification/validation process upon request for any transaction involving those two sources of funds, as the above were all common practices at the time of the invention.

4. **Claims 1-66** are rejected under 103(a) as obvious over Schutzer in view of Citibank and Nelson and Schrader. Because it would have provided a much more comprehensive and efficient system of conducting on-line payment and banking services with integrated accounts and services it would have been obvious to one skilled in the art at the time of the invention to add the teaching of Citibank, Nelson and Schrader to those of Schutzer, and to add those of Schutzer to those of the others for the same reason.

5. **Note** is taken by the examiner that should the applicant find objectionable any statements made herein by the examiner regarding inherency, implicitness, obviousness, or Official Notice, Applicant can make a proper challenge to those statements only by providing adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying those statements: a simple response requesting a reference without doing so, or a response that fails to logically refute the basic assumptions underlying the justification, will result in an improper and failed challenge and those unchallenged statements will remain the record of the case. Applicants must seasonably challenge those statements in the first response following an Office Action. If an applicant fails to do so, his right to challenge them is waived.

6. **Any inquiry** concerning this communication or earlier communications from the examiner should be directed to Richard Fults whose telephone number is 703-305-5416. The examiner can normally be reached on weekdays from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached on (703)-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



RCF

5/2/2002



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
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